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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,388	10/09/2001	Elizabeth Bates	SF0977X	4303

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EXAMINER

BELYAVSKYI, MICHAIL A

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 12/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/869,388

Applicant(s)

BATES ET AL.

Examiner

Michail A Belyavskiy

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1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21/02/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

*Claims 1-16 are pending.*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in US on 12/29/1999. It is noted, however, that applicant has not filed a certified copy of the PCT /US99/30004 application as required by 35 U.S.C. 119(b).

### ***Restriction Requirement***

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted:

- I. Claims 1-2, drawn to an isolated polypeptide comprising an amino acid sequence derived from SEQ ID NO: 2.
- II. Claims 1-2, drawn to an isolated polypeptide comprising an amino acid sequence derived from SEQ ID NO: 4.
- III. Claims 1-2, drawn to an isolated polypeptide comprising an amino acid sequence derived from SEQ ID NO: 6.
- IV. Claims 1-2, drawn to an isolated polypeptide comprising an amino acid sequence derived from SEQ ID NO: 8.
- V. Claims 1-2, drawn to an isolated polypeptide comprising an amino acid sequence derived from SEQ ID NO: 10.
- VI. Claims 3-5 and 10-12 drawn to an isolated nucleotide sequence comprising SEQ ID NO:1, encoding polypeptide derived from SEQ ID NO:2; vectors, host cells and methods of producing the said polypeptide.

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- VII. Claims 3-5 and 10-12 drawn to an isolated nucleotide sequence comprising SEQ ID NO:3, encoding polypeptide derived from SEQ ID NO:4; vectors, host cells and methods of producing the said polypeptide.
- VIII. Claims 3-5 and 10-12 drawn to an isolated nucleotide sequence comprising SEQ ID NO:5, encoding polypeptide derived from SEQ ID NO:6; vectors, host cells and methods of producing the said polypeptide.
- IX. Claim 3-5 and 10-12 drawn to an isolated nucleotide sequence comprising SEQ ID NO:7, encoding polypeptide derived from SEQ ID NO:8; vectors, host cells and methods of producing the said polypeptide.
- X. Claims 3-5 and 10-12 drawn to an isolated nucleotide sequence comprising SEQ ID NO:9, encoding polypeptide derived from SEQ ID NO:10; vectors, host cells and methods of producing the said polypeptide.
- XI. Claim 6, drawn to a fusion protein comprising an amino acid sequence derived from SEQ ID NO: 2.
- XII. Claim 6, drawn to a fusion protein comprising an amino acid sequence derived from SEQ ID NO: 4.
- XIII. Claim 6 drawn to a fusion protein comprising an amino acid sequence derived from SEQ ID NO: 6.
- XIV. Claim 6 drawn to a fusion protein comprising an amino acid sequence derived from SEQ ID NO: 8.
- XV. Claim 6 drawn to a fusion protein comprising an amino acid sequence derived from SEQ ID NO: 10.
- XVI. Claims 7-9, drawn to a binding compound which specifically binds to the polypeptide comprising an amino acid sequence derived from SEQ ID NO: 2.
- XVII. Claims 7-9, drawn to a binding compound which specifically binds to the polypeptide comprising an amino acid sequence derived from SEQ ID NO: 4.
- XVIII. Claims 7-9, drawn to a binding compound which specifically binds to the polypeptide comprising an amino acid sequence derived from SEQ ID NO: 6.

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- XIX. Claims 7-9, drawn to a binding compound which specifically binds to the polypeptide comprising an amino acid sequence derived from SEQ ID NO: 8.
- XX. Claims 7-9, drawn to a binding compound which specifically binds to the polypeptide comprising an amino acid sequence derived from SEQ ID NO: 10.
- XXI. Claims 13 and 14 drawn to a method for detecting a specific nucleic acid sequence in a sample, comprising a step of contacting a sample with a probe comprising at least 8 consecutive nucleotides of SEQ ID NO 1.
- XXII. Claims 13 and 14 drawn to a method for detecting a specific nucleic acid sequence in a sample, comprising a step of contacting a sample with a probe comprising at least 8 consecutive nucleotides of SEQ ID NO 3.
- XXIII. Claims 13 and 14 drawn to a method for detecting a specific nucleic acid sequence in a sample, comprising a step of contacting a sample with a probe comprising at least 8 consecutive nucleotides of SEQ ID NO 5.
- XXIV. Claims 13 and 14 drawn to a method for detecting a specific nucleic acid sequence in a sample, comprising a step of contacting a sample with a probe comprising at least 8 consecutive nucleotides of SEQ ID NO 7.
- XXV. Claims 13 and 14 drawn to a method for detecting a specific nucleic acid sequence in a sample, comprising a step of contacting a sample with a probe comprising at least 8 consecutive nucleotides of SEQ ID NO 9.
- XXVI. Claim 15 drawn to a method for detecting a specific antigen in a sample, comprising a step of contacting a sample with an antibody specific for SEQ ID NO: 2.
- XXVII. Claim 15 drawn to a method for detecting a specific antigen in a sample, comprising a step of contacting a sample with an antibody specific for SEQ ID NO: 4.
- XXVIII. Claim 15 drawn to a method for detecting a specific antigen in a sample, comprising a step of contacting a sample with an antibody specific for SEQ ID NO: 6.
- XXIX. Claim 15 drawn to a method for detecting a specific antigen in a sample, comprising a step of contacting a sample with an antibody specific for SEQ ID NO: 8.
- XXX. Claim 15 drawn to a method for detecting a specific antigen in a sample, comprising a step of contacting a sample with an antibody specific for SEQ ID NO: 10.

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XXXI. Claim 16 drawn to a method of screening for candidate therapeutic agent comprising a step of selecting as a target sequence a polypeptide having an amino acid sequence derived from SEQ ID NO:2.

XXXII. Claim 16 drawn to a method of screening for candidate therapeutic agent comprising a step of selecting as a target sequence a polypeptide having an amino acid sequence derived from SEQ ID NO:4.

XXXIII. Claim 16 drawn to a method of screening for candidate therapeutic agent comprising a step of selecting as a target sequence a polypeptide having an amino acid sequence derived from SEQ ID NO:6.

XXXIV. Claim 16 drawn to a method of screening for candidate therapeutic agent comprising a step of selecting as a target sequence a polypeptide having an amino acid sequence derived from SEQ ID NO:8.

XXXV. Claim 16 drawn to a method of screening for candidate therapeutic agent comprising a step of selecting as a target sequence a polypeptide having an amino acid sequence derived from SEQ ID NO:10.

3. The inventions listed as Groups I-XXXV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

As was also found in the International Search Report, the Invention of Group I was found to have no special technical feature that defined the contribution over the prior art of WO 9824906A (see entire document).

As the applicant himself elaborate in the description, the human FDF03 gene and protein , SEQ ID NO: 2 have been isolated and described previously in W0 98 24906 A.

Since Applicant's inventions do not contribute a special technical feature when viewed over the prior art they do not have a single general inventive concept and so lack unity of invention.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskyi whose telephone number is (703) 308-4232. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Michail Belyavskyi, Ph.D.  
Patent Examiner  
Technology Center 1600  
December 16, 2002

  
CHRISTINA CHAN  
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